

REMARKS

Claims 2 and 9 and their respective dependent claims are rejected under 35 U.S.C. §112 for lacking antecedent basis for the limitation “the image”, recited in the preamble of claims 2 and 9. This rejection is overcome by the amendments made to these claims.

Drawings are objected to by the Examiner. A clean set of formal drawings is herewith submitted to overcome this objection.

Claims 1-5, 7-11 and 13 are rejected under 35 U.S.C. §102(e) as being anticipated by *Daynes et al.* (U.S. Pub. 2002/0013939).

Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

The PTO provides in MPEP §2131...”To anticipate a claim, the reference must teach every element of the claim...”. Therefore, to sustain this rejection the *Daynes et al.* patent must contain all of the claimed elements of claims 1 and 8. However, the file copy install phase and the enumeration install phase, as claimed, are not shown or taught in the *Daynes et al.* patent. Therefore, the rejection is unsupported by the art and should be withdrawn.

Claims 1 and 8 include:

“performing a first file copy phase of installing programs onto the storage device to optimize file structure to support an application;

configuring a first setup process to determine at least one directory on the storage device for copying contents of a program;

performing a second enumeration phase of installing programs onto the storage device to enumerate registry, desktop and start menu items; and configuring a second setup process to cause a program to be integrated into an operating system."

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claims 1 and 8 and their respective dependent claims are not anticipated by *Daynes et al.*

Claims 5-6 and 11-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Daynes et al.* in view of the applicant's choice of design of utilizing switches to implement phases.

Applicants traverse this rejection on the grounds that the reference is defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

In the present case, the reference fails to teach the first or file copy installation phase and the second or enumeration installation phase. Thus, the rejection is improper because, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. In this context, 35 USC §103 provides that:

A patent may be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the *subject matter* as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)

Because all the limitations of claims 5-6 and 11-12 have not been met by the *Daynes et al.* patent, it is impossible to render the subject matter as a whole obvious. Thus the explicit terms of the statute have not been met and the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

The Federal Circuit has held that a reference did not render the claimed combination *prima facie* obvious in *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), because inter alia, the examiner ignored a material, claimed, temperature limitation which was absent from the reference. In variant form, the Federal Circuit held in *In re Evanega*, 829 F.2d 1110, 4 USPQ2d 1249 (Fed. Cir. 1987), that there was want of *prima facie* obviousness in that:

The mere absence [from the reference] of an explicit requirement [of the claim] cannot reasonably be construed as an affirmative statement that [the requirement is in the reference].

In *Jones v. Hardy*, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir 1984), the Federal Circuit reversed a district court holding of invalidity of patents and held that:

The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone) but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

The Federal Circuit has also continually cautioned against myopic focus on the obviousness of the difference between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole relative to the prior art as §103 requires. See, e.g., *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986).

Therefore, independent claims 1 and 8 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-13 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



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